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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,699

02/01/2006

Lorne Canvin

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

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DELIVERY MODE

05/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,699	<b>Applicant(s)</b> CANVIN, LORNE	
	<b>Examiner</b> Marie Patterson	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/1/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on 4/18/08 is acknowledged.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 18 the phrase "an internal height which is suitably sized for comfortably....", and in claim 18 the phrases "substantially reduced rate of compression" and "a durometer at a metatarsal region thereof such that the maximum compression...average weight" are vague, indefinite, and confusing. It is not clear what structural limitations applicant intends to encompass with such language.

In claim 5 the phrase "an internal height" is confusing, vague, and indefinite, it is not clear what measurement/dimension of what element applicant is referring to.

In claim 6 the phrase "a ratio of height at the metatarsal region" is confusing, vague, and indefinite because it is not clear what element height is being referred to.

In claim 4 the phrase "is plural time thickness" is confusing, vague, and indefinite.

Claim 11 contradicts the limitations of claim 9 from which it depends rendering the claim vague and indefinite.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 7, and 16-18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Meyers (4627177).

Meyers shows an insole (shown in the figures) for placement in a conventional well known shoe (column 4 lines 52-58) which inherently has an outsole, shoe body, and footbed. The insole has a thickness in the ranges claimed and Meyers specifically suggests different thicknesses, sizes, etc (column 3 lines 3-22). The insole thickness in the metatarsal region and the heel region are shown as substantially the same (figures 2 and 3). In reference to claim 18, Meyers shows an insole for use in a conventional shoe inasmuch as the claim defines such.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers (4627177).

Meyers discloses the claimed invention except for the exact thicknesses/dimensions of the footbed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the footbed and insole with the dimensions claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Meyers discloses the claimed invention except for the exact materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use materials with qualities as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

8. Claims 1, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yung (6453578).

Yung shows an insole (31) with inserts (34, 36, and 40) for use in a conventional shoe which inherently has an outsole, footbed, and shoe body substantially as claimed except for the exact thickness of the insole. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the footbed and insole with the dimensions claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yung in view of Looney (4408402).

Yung shows an insole and shoe substantially as claimed except for the arch and heel insert being combined in one insert. Looney teaches combining a heel and arch insert into one insert (see figure 3). It would have been obvious to combine the heel and arch inserts as taught by Looney in the insole of Yung to reduce the number of element, to increase the area of cushioning, etc..

In reference to the exact materials and shore hardnesses, discloses the claimed invention except for the exact materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use materials with qualities as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to make the footbed and insole with the hardnesses claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers '177 in view of Suginaka (5063692).

Meyers '177 as described above shows a shoe and insole substantially as claimed except for the peripheral sides of the metatarsal region being raised. Suginaka teaches raising the peripheral side portions of the metatarsal region (see figures 4 and 6-8) of an insole. It would have been obvious to raise the peripheral portions of the insole as

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taught by Suginaka in the insole of Meyers to facilitate proper positioning of the foot, and proper walking positioning of the foot.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571)273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

/Marie Patterson/  
Primary Examiner  
Art Unit 3728